

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

September 9, 2002
Paper No. 12
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Human Synergistics, Inc.**

Serial No. 75/**572,457**

Joan H. Lowenstein of Jaffe, Raitt, Heuer & Weiss, P.C. for **Human Synergistics, Inc.**

David T. Taylor, Trademark Examining Attorney, Law Office 112
(Janice O'Lear, Managing Attorney).

Before **Seeherman, Hohein and Bottorff**, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Human Synergistics, Inc. has filed an application to register the mark "THE LEADER WITHIN" for goods and services identified as follows: "computer programs used for self-testing, consulting, assessment and motivational training" in International Class 9; "books, printed manuals, stationery, instructional materials, brochures and printed materials relating to business consulting and motivational training" in International Class 16; and "business and management consulting services, [and] management research" in International Class 35.¹

¹ Ser. No. 75/572,457, filed on October 19, 1998, which with respect to all three classes alleges a date of first use and first use in commerce of September 1, 1998.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods and services, so resembles the mark "LEADING FROM WITHIN," which is registered by the same entity for "questionnaires, workbooks, and printed teaching materials in the field of leadership"² and "educational services, namely conducting training workshops and seminars for individuals and organizations in the field of leadership and distributing course materials in connection therewith,"³ as to be likely to cause confusion, or mistake or to deceive. In addition, registration has been finally refused pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), on the ground that the identification of the goods in International Class 9 is "unacceptable as indefinite" because, as stated in the final refusal, it "merely indicates the fields of use rather than the functions of the computer software."

Applicant has appealed. Briefs have been filed, but an oral hearing was not held.⁴ We affirm the refusals to register.

Turning first to the issue of likelihood of confusion, our determination thereof under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to

² Reg. No. 2,015,841, issued on November 12, 1996, which sets forth a date of first use anywhere and in commerce of May 17, 1995.

³ Reg. No. 2,015,839, issued on November 12, 1996, which sets forth a date of first use anywhere and in commerce of May 17, 1995.

⁴ Although applicant, in its initial brief and again with its reply brief, requested "oral argument for this appeal," it subsequently notified the Board after an oral hearing was scheduled that it "elected to waive oral argument."

the pertinent factors as set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and/or services and the similarity of the marks.⁵

With respect to consideration of the goods and services at issue, we agree with the Examining Attorney that, as stated in his brief, the "goods and services are identical in some respects and highly related in others." Applicant, as the Examining Attorney also accurately observes in his brief, "apparently concedes ... the similarity of the goods and services ... by offering no arguments against the examiner's findings on this issue at any point during the prosecution of this application." Such is likewise true with respect to applicant's reply brief, which we note lacks any mention of the issue.

In any event, it is plain from the brochure submitted as applicant's specimen of use for its services that its "business and management consulting services, [and] management research" services are, as the Examining Attorney contends in his brief, "highly related to the registrant's educational training workshops and seminars for individuals and organizations in the field of leadership." As its brochure explains, applicant's *"The*

⁵ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and/or services] and differences in the marks."

Leader Within development program" is "[a]n intensive, high-impact workshop" which "provides a practical, immediately applicable development process that emphasizes the value of the self and the ability to reach and exceed one's potential." Such brochure further states, among other things, that "[p]articipants discover ... [w]hich 'self-leadership' behaviors enhance their relationships and approach to tasks"; that "*The Leader Within* can be delivered as a one or one-half day workshop OR as a self-directed, self-paced learning experience"; and that "[t]he 156-page *Participant Workbook* contains everything the participant needs to successfully complete the training." Thus, as the Examining Attorney points out, "[t]hese excerpts clearly demonstrate that the applicant's services, though couched in different terminology, are nearly identical to the services provided by the registrant and feature the same subject matter.

In addition, the Examining Attorney insists that the "goods provided by the applicant, namely its computer software and printed educational material, are all related to the field of motivational training." Specifically, with respect to the relationship between applicant's "computer programs used for self-testing, consulting, assessment and motivational training" and its "books, printed manuals, stationery, instructional materials, brochures and printed materials relating to business consulting and motivational training," on the one hand, and registrant's "questionnaires, workbooks, and printed teaching materials in the field of leadership" and its "educational services, namely conducting training workshops and seminars for

individuals and organizations in the field of leadership and distributing course materials in connection therewith," on the other hand, the Examining Attorney correctly maintains that, not only are such goods and services "each focused on the field of motivational and self-improvement," but "applicant and registrant provide identical printed materials on the same subject matter." In fact, as identified, applicant's various items of printed matter encompass those of registrant. Contemporaneous use of the same or similar marks in conjunction with the goods and services of applicant and registrant would therefore be likely to cause confusion as to the source or sponsorship thereof.

Turning, then, to consideration of the respective marks, applicant argues that "[t]he two marks are different in character and create distinct commercial impressions, negating a likelihood of confusion.⁶ Applicant essentially asserts, in this regard, that due to the high degree of suggestiveness inherent in such terms as "leading," "leadership" and "leader" with respect to goods and services devoted to the general subject matter of leadership, "[c]onsumers of services and products relating to executive and management training are not likely to be confused

⁶ Although applicant, in its initial brief, refers for the first time to the results of "[a] search for books on leadership sold by Amazon.com" as demonstrating, by the titles of such books, that "[t]he terms 'leading,' 'leadership,' and 'leader' are very common in the business of motivational training," such evidence is plainly untimely under Trademark Rule 2.142(d). Moreover, while the Examining Attorney has not objected thereto on such ground in his brief, neither has he specifically discussed the evidence referred to by applicant or otherwise treated it as if it were properly of record. Accordingly, no further consideration will be given thereto.

because ... even slight differences [in the associated marks] will be distinguishing." In particular, applicant insists that:

While THE LEADER WITHIN indicates the applicant's program objective of discovering personal performance potential, LEADING FROM WITHIN indicates a program objective of training an already-established leader. To knowledgeable consumers of the relevant products and services, THE LEADER WITHIN and LEADING FROM WITHIN create distinct commercial impressions and therefore there will be no likelihood of confusion under Section 2(d).

We agree with the Examining Attorney, however, that when considered in their entirety, the respective marks are so similar in sound and appearance that their slight differences in connotation are insufficient to preclude a likelihood of confusion. As the Examining Attorney correctly points out in his brief, a side-by-side comparison of marks is not the proper test to be used in determining the issue of likelihood of confusion inasmuch as it is not the ordinary way that customers will be exposed to the marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the concomitant lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is accordingly on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. See, e.g., Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973); Envirotech Corp. v. Solaron Corp., 211 USPQ 724, 733 (TTAB 1981); and Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106, 108 (TTAB

1975). Here, as the Examining Attorney persuasively notes, "[a] purchaser who retains only a general impression of trademarks is not likely to distinguish between ... THE LEADER WITHIN and LEADING FROM WITHIN," given that such marks clearly "are highly similar in sound and appearance."

As to applicant's contention that "subtle distinctions" in connotation are sufficient to distinguish the respective marks, we concur with the Examining Attorney that by coupling the words "LEADER" and "LEADING" with the term "WITHIN" so as to form the marks "THE LEADER WITHIN" and "LEADING FROM WITHIN," the overall commercial impressions engendered thereby are highly similar. Plainly, leading is what a leader does. Although obviously the words "LEADER" and "LEADING" are highly suggestive of applicant's and registrant's respective goods and services, our finding of a likelihood of confusion is not based solely on the presence of such words in the marks at issue but on the fact that both marks also include the term "WITHIN." Both marks as a whole consequently convey similar commercial impressions in that they engender, although in slightly different fashions, a notion of leadership which arises from or is attributable to the values within a person. In view of such similarity in impression, and in light of the substantial similarities in sound and appearance, contemporaneous use of the marks at issue in connection with the respective goods and services is likely to cause confusion as to the origin or affiliation of such goods and services.

Turning, then, to the remaining issue in this appeal, the Examining Attorney maintains that the identification of the

goods in International Class 9 of applicant's application as "computer programs used for self-testing, consulting, assessment and motivational training" is "unacceptable because it fails to identify the functions of the applicant's computer programs with the level of specificity required to allow the office to reach judgments regarding potential conflicts." Instead, the Examining Attorney asserts, "the identification refers primarily to the applicant's field of use."

Applicant, on the other hand, urges in its reply brief that the language used to identify its computer programs is acceptable inasmuch as it conforms to Office policy with respect to identifications of such goods. Specifically, applicant cites former TMEP §804.03(b), which in the latest version (3rd ed., rev. 1, dated June 2002) is renumbered as TMEP §1402.03(d), for the following guideline (emphasis added by applicant):

Due to the proliferation of computer programs over recent years and the degree of specialization that these programs have, broad specifications such as "computer programs in the field of medicine" or "computer programs in the field of education" should not be accepted ***unless the particular function of the program in that field is indicated.*** For example, "computer programs for use in cancer diagnosis" or "computer programs for use in teaching children to read" would be acceptable.

Applicant contends that the identification of its computer programs "clearly falls into the category approved of in the TMEP section noted above" and asserts, furthermore, that "[t]he terms 'self-testing' and 'motivation training,' for example, need no further definition."

We concur with the Examining Attorney, however, that the identification of goods in International Class 9 of the application is indefinite, although we find that it is the failure to specify the field(s) in which applicant's computer programs are used, rather than the absence of their functions, which is lacking. In particular, as further provided in current TMEP §1402.03(d) (*italics in original*):

Typically, indicating only the intended users, field, or industry will not be deemed sufficiently definite to identify the nature of a computer program. However, this does not mean that user, field or industry indications can never be sufficient to specify the nature of the computer program adequately.

....

Generally, an identification of "computer software" will be acceptable as long as *both* the function/purpose *and* the field are set forth. Some general wording is allowed.

Here, while the language "used for self-testing, consulting, assessment and motivational training" clearly sets forth the functions of applicant's "computer programs," there is no indication as to the field(s) in which such goods customarily find application. By contrast, we observe that the Examining Attorney raised no objection to the analogous situation involving the identification of applicant's goods in International Class 16, which he apparently found to be acceptable because the phrase "relating to business consulting and motivational training" adequately serves to specify the field of use of applicant's "books, printed manuals, stationery, instructional materials, brochures and printed materials."

Ser. No. 75/572,457

Decision: The refusals under Sections 2(d) and 1(a) are affirmed.